1. Claims 1-16 remain pending in the application.

5   3. Claims 1,2,5,6,9,10,13,14 stand rejected under 35 U.S.C. 102(e) as being anticipated by Ellison et al. (6,487,547).

4-7. Specifically, the Office Action held that, as per claim 1, 5, 9 and 13, "Ellison teaches a method for monitoring and managing a remote server in a computer system network via a
10   console, wherein one and only one communication line existing between the server and the console, the method comprising the steps of: a) servicing said communication line in the server via a server database management system protocol, by receiving server management operation requests from the console and returning the requested information to the console (e.g. col. 11, lines 59-65); and b) using a server database management system for recognizing the server
15   management operation requests being in a stored procedure call format, and for invoking an appropriate stored procedure encoding the requested server management operation (e.g. col. 9, lines 25-31 and figure 1B)."

It is respectfully submitted that the Ellison reference does not have the quoted language either in
20   its entirety or partially. No language quoted by the Examiner appears in Ellison reference and the text is taken verbatim from claim 1 of the present invention. Furthermore, Ellison reference does not have any of the two steps (a) - (b) of the independent claims of the present invention.

Present invention, as claimed, is directed to a system and method for monitoring and managing a
25   remote server via a console, wherein one and **only one communication line and protocol** exists between the server and the console, in order to avoid pitfalls of the conventional systems and reduce use of communication resources, such as sessions. As shown in Specification p. 2-5, the conventional systems use 1) two communication lines and separate protocols for 2) database functions, and 3) operating system functions and 4) an additional communication protocol for
30   connectivity purposes on each communication line. As shown in FIG. 2, in prior art there are two communication lines: server-management-based line 203 and database protocol-based line 205

and a server DBMS 209 for database commands and a server management agent and daemon 207 for operating system commands.

As shown FIG. 3 and in Specification on p. 11-15, **only a database protocol-based line** and
5   **DBMS protocol** are used in the present invention where the server uses DBMS to receive the console requests, which are in **standard stored procedure call format**, and the DBMS executes the appropriate stored procedure to invoke an operating system routine, file I/O routine or a database command, according to the request, without special reconfiguration and without a separate protocol. Thus, in the present invention, a database management protocol performs all
10   server management functions and it only uses standard hardware and software configuration and an existing DBMS protocol, based on an industry standard, such as DRDA, ODBC, JDBC.

As claimed in independent claims, in step a) the method **services** the communication line in the server via a **server database management system protocol**, by receiving server management
15   operation requests from the console and returning the requested information to the console. As shown in step b) the method is using a server database management system for recognizing that the server management operation **requests are in a stored procedure call format**, and for invoking an appropriate stored procedure encoding the requested server management operation.

20   These features are recited in the claims 1-16 and throughout the Specification and are not shown in the Ellison reference which does not show any features of the present invention, operating in the same way and for the same purpose. Namely, reference Ellison shows a stand-alone, special database appliance which is tailored by a user for a specific application, with limited complexity and features, in order to reduce the cost (col. 2, li. 18-26). As the title and Abstract imply, a
25   console helps a remote server to configure itself with a special purpose operating system, according to its application and environment configuration metadata. Thus, the server can be configured either to an operating system configuration or a database server configuration, and can interact with the console either at the database system level, operating system level or hardware level. Sited col. 11, li. 59-65 and col. 9, li. 24-31sections are somewhat deceptive
30   where they state that the server operates at both levels, because it operates at only one level at the time.

As shown in col. 5, li. 46-58 of Ellison, the act of configuring the server is used to remove the general purpose routines, such as operating system routine, so the user cannot directly access the file system services of the operating system, for example. As shown in col. 8, li. 47-61, the server is tailored to either analytical or I/O intensive processing. The reference does not specifically point out how the messages are sent and does not describe the communication lines and protocols used but there are numerous protocols mentioned. For example, in section starting in col. 10, li. 62 to col. 11, li. 3, it mentions web requests arriving according to HTTP protocol which have to be converted by the web database software to conform to the database language used by the database server (SQL or PL/SQL). Moreover, Ellison reference needs two special agents, according to col. 12, li. 16-25, where it states that the server has to include a simple network management protocol SNMP compliant agent which then uses special commands to a multi-level management agent.

Furthermore, Ellison reference does not have any of the two steps (a) - (b) of the independent claims of the present invention, because it does not teach use of only one, database management protocol, to perform one of the functions on a standard database management system managed server, without reconfiguration, all of which were a long-felt need in this field. Moreover, Ellison does not show, teach or suggest or even mention special DBMS routine format named "stored procedure calls", and is not using them in console requests, as is implied in Office Action reference to col. 9, li. 25-31 section of Ellison, which does not even mention stored procedure calls. Furthermore, the Office Action in sections 12-22 admits that Ellison does not teach the method where file I/O routines are invoked by stored procedure calls. Further, Ellison components cannot be integrated into an existing DBMS-based server system.

To establish prima facie case of anticipation of a claimed invention, the standard for determining novelty under 35 USC 102 was been set forth by the courts *In re Bartleb*, 300 F.2d 942, 133 USPQ 204 (CCPA 1962), and *Hupp v. Siroflex of America Inc.*, 122 F.3d 1456, 43 USPQ2d 1887 (Fed. Cir. 1997), which states that the reference must be identical in all material aspects.

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MPEP Sec. 2131, under the title TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM, states that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Therefore, it is clear that the standard for determining novelty under 35 USC 102 to establish prima facie case of anticipation has not been met for the claimed invention, because Ellison reference does not have any and all elements of independent claims, is from a completely different field, has different components, works in a different mode of use and produces different results. Thus, independent claims 1, 5, 9 and 13 and all claims dependent upon them in the present invention recite novel structure and therefore distinguish over the cited prior art, Ellison, and are not anticipated by it under 35 U.S.C. 102(e).

8-11. Examiner stated that claims 2, 6, 10 and 14 stand rejected because "Ellison teaches the method wherein the request for the server management operation comprises one or more commands selected from a group comprising server operating system routines and file I/O routines (e.g. col. 8, lines 45-61)."

As shown above and in the quoted section, Ellison specifically tailors server's configuration for either I/O intensive or analytical operations and does not show how. In the present invention a server does not need special reconfiguration and DBMS handles all requests through a standard DBMS protocol using requests in stored procedure calls format. Because, it is clear from above that Ellison reference does not use only one, DBMS protocol and does not use stored procedure calls format of independent claims of the present invention and that it is from a completely different field, has different components, works in a different mode of use and produces different results, thus, independent claims 1, 5, 9 and 13 and all claims dependent upon them in the present invention, including claims 2, 6, 10 and 14 recite novel structure and therefore distinguish over the cited prior art, Ellison, and are not anticipated by it under 35 U.S.C. 102(e).

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13-17. Claims 3, 7, 11, 15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ellison in view of Leung et al. Examiner stated that, as per claim 3, Ellison does not specifically teach the method wherein the file I/O routines being invoked by the server DB2 database

5   management system stored procedure calls but that Leung teaches the method wherein the file I/O routines being invoked by the server DB2 database management system stored procedure calls, and that it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Ellison with Leung with the motivation to use a move universal database procedure calls such as DB2.

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As shown above, Ellison reference does not have any of the two steps (a) - (b) of the independent claims of the present invention, because it does not teach use of only one, database management protocol, to perform one of the functions on a standard database management system managed server, without reconfiguration, and does not show, teach or suggest or even mention special

15   DBMS routine format named "stored procedure calls", and is not using them in console requests.

Office Action fails to point out which section of Leung reference teaches elements of present invention. Leung does teach use of system stored procedure calls but only for file transfer and does not use the same DBMC protocol for operating system commands, etc., as does the present

20   invention, as claimed. The Examiner did not specifically point out, as is required, why the rejected claims are deemed anticipated or obvious and where all of the specific limitations recited are found in the prior art. For Leung reference there is no specific section that is referenced in the Office Action and how it could be combined with Ellison reference. Examiner relies on Ellison and Leung for disclosing all the limitations of the claims but fails to point out

25   how his quotations from the claimed invention, even if existent in the cited prior art, are related to the specific limitations. The Examiner's position that it would be obvious to combine references with mere assertion that motivation would be to use more universal database procedure calls, such as DB2, is insufficient and not pointed out by the references themselves.

30   Moreover, in order to satisfy rejection of a limitation of a claim, the Examiner uses impermissible quotes and impermissible hindsight to modify the teachings. It is respectfully

submitted that the prior art does not have the quoted language either in its entirety or partially. It is the impermissible hindsight by the Examiner that the teachings of Ellison can be interpreted the way presented. Moreover, the Examiner was impermissibly picking and choosing isolated disclosures of conventional database terms in the prior art to assert that the claims are

5   unpatentable.

As stated in MPEP Sec. 706.02(j), 35 U.S.C. 103 authorizes a rejection where, to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references. After indicating that the rejection is under 35 U.S.C. 103, the examiner **should** set

10   forth in the Office action:

(A)   the **relevant** teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,
(B)   the **difference** or differences in the claim over the applied reference(s),
(C)   the **proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter,**

15   and
(D)   **an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.**

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion

20   or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d

25   1438 (Fed. Cir. 1991). See MPEP Sec. 2143 - 2143.03 for decisions pertinent to each of these criteria.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line

30   of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). See MPEP Sec. 2144 - 2144.09 for examples of reasoning supporting obviousness rejections.

35   Office Action is not following this law because the referenced prior art is not from the same field, references are obviously not solving the same problem, and a combination or modification must be shown in the prior art itself. As shown by the Applicant, the teachings of the referenced prior art are not relevant to the claimed invention, the proposed modifications of the applied reference(s) necessary to arrive at the claimed subject matter are not shown, and an explanation

40   about why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification was not precise.

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Further, each cited reference is individually complete and they do not suggest a combination or modification and are impossible to combine. Case *Amgen, Inc. v. Chugai Pharmaceutical Co.,* 927 F.2d 1200, 18 USPQ2d 1016 Fed. Cir. 1991) is on point as is the case *In re Gordon,* 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984), which held that where there is no technological motivation for a modification or if a proposed modification of reference would destroys intent, purpose or function of the reference, the prima facie case of obviousness is not properly established. This law was not followed in the Office Actions either. It is impermissible to use "hindsight reconstruction to pick and chose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fine,* 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

The Examiner has not established a prima facie case of obviousness because the three basic criteria stated above, which must be met, were not met because he did not point out: to any suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings, a reasonable expectation of success was not shown (and is impossible) and that the prior art reference(s), which must teach or suggest all the claim limitations, do so here, which they do not. Furthermore, the Examiner did not satisfy the initial burden to provide some suggestion in the references of the desirability of doing what the inventor has done, because to support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

The methods taught by these two references are completely different of the present invention and are from different art fields, satisfy a different need and cannot be combined. Moreover, it is shown that they do not perform any elements of the independent claims and they cannot use only one, DBMS protocol and stored procedure calls format of independent claims of the present invention to transfer database and operating system commands quickly and efficiently, in a standard system with an existing, standard DBMS protocol. Moreover, they are from a completely different fields, have different components, work in a different mode of use and produce different results. Thus, these references cannot be used to invalidate independent claims

1, 5, 9 and 13 and all claims dependent upon them in the present invention. Because none of the referenced prior art teaches elements (a) to (b) of claims 1, 5, 9 and 13, which are the main steps of the present invention, their combination is not a valid reason for rejection of these independent claims and claims dependent thereof, such as 3, 7, 11 and 15. Therefore, each cited reference, by itself or in combination, cannot be used to invalidate these claims because they fail to teach any and all the steps of these claims.

18-22. Claims 4,8,12,16 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ellison in view of Anand et al. Office action stated that, as per claim 4, Ellison does not specifically teach the method wherein the returned request information having a database table format but that Anand teaches the method wherein the returned request information having a database table format (e.g. Abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Ellison with Anand with motivation for a better way of marshalling data between the console and the server.

As shown above, Ellison reference does not have any of the two steps (a) - (b) of the independent claims of the present invention, because it does not teach use of only one, database management protocol, to perform one of the functions on a standard database management system managed server, without reconfiguration, and does not show, teach or suggest or even mention special DBMS routine format named "stored procedure calls", and is not using them in console requests.

Anand does teach use of tables but so does almost every database invention. It does not use the same DBMC protocol for operating system commands, etc., as does the present invention, as claimed. The Examiner did not specifically point out, as is required, why the rejected claims are deemed anticipated or obvious and where all of the specific limitations recited are found in the prior art and how they can be combined. Examiner relies on Ellison and Anand for disclosing all the limitations of the claims but fails to point out how his quotations from the claimed invention, even if existent in the cited prior art, are related to the specific limitations. The Examiner's position that it would be obvious to combine references with mere assertion that motivation would be to have better way of marshalling data is insufficient and not pointed out by the references themselves.

Moreover, in order to satisfy rejection of a limitation of a claim, the Examiner uses impermissible quotes and impermissible hindsight to modify the teachings. It is respectfully submitted that the prior art does not have the quoted language either in its entirety or partially. It

5   is the impermissible hindsight by the Examiner that the teachings of Ellison can be interpreted the way presented. Moreover, the Examiner was impermissibly picking and choosing isolated disclosures of conventional database terms in the prior art to assert that the claims are unpatentable.

10   Office Action is not following this law because the referenced prior art is not from the same field, references are obviously not solving the same problem, and a combination or modification must be shown in the prior art itself. As shown by the Applicant, the teachings of the referenced prior art are not relevant to the claimed invention, the proposed modifications of the applied reference(s) necessary to arrive at the claimed subject matter are not shown, and an explanation

15   about why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification was not precise.

Further, each cited reference is individually complete and they do not suggest a combination or modification and are impossible to combine. Case *Amgen, Inc. v. Chugai Pharmaceutical Co.,*

20   927 F.2d 1200, 18 USPQ2d 1016 Fed. Cir. 1991) is on point as is the case *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984), which held that where there is no technological motivation for a modification or if a proposed modification of reference would destroys intent, purpose or function of the reference, the prima facie case of obviousness is not properly established. This law was not followed in the Office Actions either. It is impermissible to use

25   "hindsight reconstruction to pick and chose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

The Examiner has not established a prima facie case of obviousness because the three basic criteria stated above, which must be met, were not met because he did not point out: to any

30   suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference

teachings, a reasonable expectation of success was not shown (and is impossible) and that the prior art reference(s), which must teach or suggest all the claim limitations, do so here, which they do not. Furthermore, the Examiner did not satisfy the initial burden to provide some suggestion in the references of the desirability of doing what the inventor has done, because to support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

The methods taught by these two references are completely different of the present invention and are from different art fields, satisfy a different need and cannot be combined. Moreover, it is shown that they do not perform any elements of the independent claims and they cannot use only one, DBMS protocol and stored procedure calls format of independent claims of the present invention to transfer database and operating system commands quickly and efficiently, in a standard system with an existing, standard DBMS protocol. Moreover, they are from a completely different fields, have different components, work in a different mode of use and produce different results. Thus, these references cannot be used to invalidate independent claims 1, 5, 9 and 13 and all claims dependent upon them in the present invention. Because none of the referenced prior art teaches elements (a) to (b) of claims 1, 5, 9 and 13, which are the main steps of the present invention, their combination is not a valid reason for rejection of these independent claims and claims dependent thereof, such as 4, 8, 12 and 16. Therefore, each cited reference, by itself or in combination, cannot be used to invalidate these claims because they fail to teach any and all the steps of these claims.
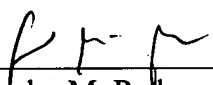
The prior art made of record and not relied upon is considered even less pertinent to the rejections.

Therefore, all submitted claims are allowable over the cited reference and their reconsideration is respectfully requested. None of the cited references discloses the subject matter and features of claims 1-16 of the present invention and, even if they did show some individual features, they

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would not be able to meet the claims of the present invention which provide new and unexpected results over these references and are thus not anticipated under Section 102 and unobvious and patentable under Section 103. In view of the above, it is submitted that this application is now in good order for allowance, which applicant respectfully solicits. Should matters remain which the Examiner believes could be resolved in a telephone interview, the Examiner is kindly requested to telephone the applicant's undersigned attorney. No additional fee is required in connection with this communication since the Amendment is faxed within three months from the Final Office Action. However, any underpayment is authorized to be charged to Deposit Account Number **09-0460** in the name of IBM Corporation.

Respectfully submitted,

Date: <u>June 4, 2004</u>

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